SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 411

MONROE AUTO EQUIPMENT COMPANY,
Petitioner,

v.

SUPERIOR INDUSTRIES, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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Opinions Below

The opinion of the Court of Appeals is at 332 F. 2d 473 (Appendix A, infra i-xxi, 141 USPQ 710). The District Court's opinion is at 220 F. Supp. 941 (Appendix B, infra xxii-xxxiii; 138 USPQ 385, except for material later submitted by counsel as directed, infra xxiii).

Jurisdiction

The judgment of the Court of Appeals was dated May 22, 1964. This Court's jurisdiction is invoked under 28 U. S. C. § 1254(1).

Questions Presented

1. May 35 U. S. C. § 103 be made to turn on structural similarity rather than conceptual unobviousness, without regard to well-settled indicia of the latter including extensive prior efforts with failure and the presumption of validity?

2. Can evidence not clear and convincing be adequate proof of prior knowledge and use?

Statutory Provisions

The statutory provisions involved are 35 U. S. C.:

> "§ 102. Conditions for patentability; novelty and loss of right to patent
>
> "A person shall be entitled to a patent unless—
>
> "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent * * *
>
> "§ 103. Conditions for patentability; non-obvious subject matter
>
> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case

This is a non-jury* action for infringement of Walker United States Patent No. 2,896,938.**

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*A jury action for infringement of this patent is already before this Court on petition for certiorari. *Monroe Auto Equipment Company* v. *Heckethorn Manufacturing & Supply Company*. (October Term, 1964, No. 374).

**Another patent as well was involved below (App. i), but no question is raised hereby with respect thereto.

Jurisdiction below arose, of course, under the patent laws (28 U. S. C. § 1338(a)).

Proceedings Below

The District Court, on a record including many and voluminous exhibits and a 1111-page trial transcript reflecting repeated recognition of the presence of knotty issues*, rendered a short opinion (infra xxii-xxiii) concluding that the patent was invalid for lack of invention over a long list of "prior art" including a "Knoedler device".

The Court of Appeals affirmed (App. i-xxi), saying (App. vi):

> "What appellant desires us to do with respect to the *obvious* [**] lack of invention found in appellant's device is to substitute our judgment for that of the trial court."***

Just the same, in rationalizing its own conclusion of lack of invention, the Court of Appeals mentioned six patents (App. vii-x), not one of which was included in the list of

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*For example, on the issue of unobviousness, the Court said (T. 1050), plainly referring to most or all of the very patents later listed (App. xxii, xxiv-xxv, xxvi-xxvii) in its opinion and in Findings of Fact 9 and 14 (e.g., App. xxiv-xxv, xxvi-xxvii), and earlier pressed by respondent (T. 635-645; 649-668):

> "[M]y offhand impression is I am not impressed by most of these patents as prior art. So I don't need any argument on those. . . ."

And as to the alleged Knoedler device, about which more later, it said (T. 1050):

> "I realize I am not saying I accept all of the testimony of the Knoedler's, I am not saying I do. . . ."

**Emphasis ours throughout.

***The Court went on that this was so whether questions of fact or of law were involved (App. vi). That certain of both were is plain. (Reflecting the former was, e.g., denial earlier of respondent's motion for summary judgment (R. 1, p. 114 ["R" refers to a volume of the record certified to this Court])).

patents on which the District Court had leaned (infra xxii).*

A Last Step Past Sleeveless Spring-Around-Shock Suspensions

True it is that the combination of the Walker patent is a simple one. For present purposes, it can be thought of as the combination of a conventional shock absorber (for dampening, not support), a coil spring around the shock absorber (for support), and an elongated nonmetallic (e.g., rubber) sleeve in an annular space left between the "shock" and spring.** Claims*** to this "combination"† embody, and are animated by, Brooks Walker's disclosure that such a sleeve so placed provided a desirable suspension device.‡

*The Court of Appeals' only mention of those patents was in that portion of its opinion (App. xiii-xvi) concluding (wrongly, infra 14) that any presumption of validity had been dissipated because those particular patents were not listed at the end of the patent.

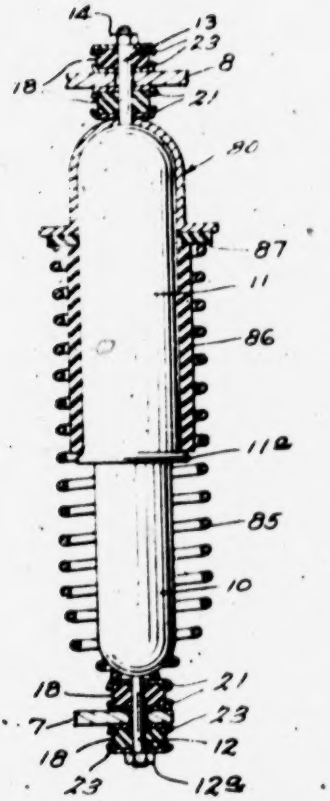
**The single drawing of the patent, reproduced infra 5, shows a portion of the shock absorber at 11, the spring at 85, and the sleeve at 86.

***Claims 2, 3, and 4 are asserted in this action (App. 1), and claim 3 is illustrative (Ex. 1):

> "3. In a suspension device, a hydraulic direct-acting tubular shock absorber having relatively movable telescopic parts, a coil spring sleeved over said shock absorber, the inside diameter of said spring being larger than the outside diameter of said shock absorber, an elongated nonmetallic tubular spacer sleeve fitted over said shock absorber and disposed in the space between said shock absorber and said coil spring, said spacer sleeve resisting lateral movement of the coil spring so that said shock absorber and coil spring are maintained in spaced substantially concentric relationship."

†In the language of the enormous and socially important case law of patents.

‡The relationship here between the legally formalized "claims" of specified embodiments and the practical, real life conception underlying the claims is of the very fabric of patent law. Whether any contribution present was "obvious" (35 U. S. C. § 103, supra 2), or any embodiment claimed was "anticipated" (35 U. S. C. § 102(a), supra 2) are other questions.



Simple as the whole thing may at first blush seem; no one questions the enormous impact of putting a sleeve thus made and placed to work in the real world of events. Plaintiff's sales of thus sleeved suspension devices exceeded $25 Million Dollars in its first three years (T.* 321). Defend-

*"T." refers to the trial transcript. Pages 1-181, 185-358, 362-596, 603-798, 801-977, and 980-1152 appear respectively in volumes 2 through 7 of the record certified to this Court.

ant's sales of kits to make up the sleeved combination (by customers using their old shock absorbers within the sleeve) were in the hundreds of thousands of dollars (T. 960-1). Like defendant's, sales of the sleeved devices by respondent in *Heckethorn* (October Term, 1964, No. 374) were plainly at high volume. The same may be said of yet another competitor, Champ-Items, Inc., which also contested the validity of the patent to an adjudication on the merits (Ex. 25), *Monroe Auto Equipment Company* v. *Champ-Items, Inc.* (E. D. Mo., No. 59 C 398(3)).

Some indication that obviousness was less obvious than the Court of Appeals thought (supra 3) lies in the jury's verdict of non-obviousness in *Champ-Items*, a verdict on which the Court entered judgment (Ex. 25) despite defendant there's moving for j. n. o. v. (Ex. 43, 44).*

There is also the extensive acquiescence of members of the industry. Thus, seven defendants, in as many different actions, entered into consent decrees holding this patent (five of them so held as to a second as well) valid and infringed (Ex. 23, 31, 33, 34, 35, 36, 37). Six non-exclusive licenses under this (and another) patent were signed (Ex. 22, 24, 28, 29, 30, 32).

Beyond all that were the repeated failures of those seeking to provide the art with suspension devices, and the record shows many who sought to provide a satisfactory coil-around-shock suspension device, to hit on a sleeve as Walker did. Thus coil-around-shock suspension devices are shown to have interested at least thirteen earlier patentees**, over

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*While damages of only $1 were awarded, so far as appears this was owing to a failure to give the notice called for by 35 U. S. C. § 287.

**Ex. 54 (United States Patents 2,158,488; 2,321,832; 2,344,896; 2,621,919; 2,653,681; 2,756,045; 2,806,713; British Patents 565,630 and 719,661; French Patents 1,044,393 and 1,059,988), Ex. C (British Patent 435,361), and Ex. D (Italian Patent 467,071).

a period going back of Walker twenty years. There was considerable evidence too of prior efforts to provide better "helper" suspensions generally (Ex. 53), a need importantly met by the Walker device (T. 1015-1018).

Neither court below questioned the testimony that Walker's contribution not only made possible reducing noise (T. 248), but as well importantly made possible use of longer springs without buckling (T. 248, 406-7) and prevention of early failure owing to fatigue and corrosion (T. 237, 227). The difference between the patented device and the sleeveless prior art suspension devices was quite simply, as a matter of common sense, the difference between success and failure.

Knoedler's Alleged Sleeved Suspension

After quoting extensively (App. xvii-xx) from counsel-prepared findings* implementing the District Court's initial one-sentence conclusion (App. xxii-xxiii),** the Court of Appeals said (App. xx-xxi):

> "Appellant urges upon us that much of this evidence was *untrustworthy and not possible of belief*. That is argument better made to the district court than to us. *Conceding . . . that a different result could have been arrived at by the district court, does not solve our problem. . . . The court's conclusions on disputed issues of fact are binding on us, unless we find them clearly erroneous.*"

*This Court recently said of such findings, *United States v. El Paso Gas Co.*, 376 U. S. 651, 656 (1964) that although "not to be rejected out-of-hand, and [to] stand if supported by evidence": "Those drawn with the insight of a disinterested mind are, however, more helpful to the appellate court."

**"Respecting the Knoedler device the proof was *clear and convincing* that such device was known and used by others [prior to May, 1954, Walker's original filing date]."

The Court of Appeals thus treated the alleged Knoedler device as established despite its assumption that proof of it, far from being "clear and convincing", might even on balance have been properly otherwise found. The Court of Appeals' unwillingness to regard the Knoedler evidence as clear and convincing is understandable.

Not even the existence in the critical period of a non-metallic sleeved Knoedler suspension device was shown by any record or non-memory evidence. Much was made at the trial of some suspension device sales literature Knoedler obtained in 1953 (in particular, Ex. AF). However, the District Court, and finally even respondent's counsel, agreed that the sleeve could not be distinguished (T. 550, 555-560, 603, 838). The only non-memory evidence even tending to support existence of a sleeved device in the critical period was Knoedler's patent application (Ex. AL). This alone, consistent as it was with other inferences*, falls far short of the requisite standard of proof, particularly in view of the other evidence here.

For if the voluminous record did anything, it dramatized this Court's repeated admonition (infra 17) that memory testimony is little to be credited in this sort of situation. While at the beginning some of the witnesses testified freely of what they remembered, in the end even they hardly pretended to remember anything not plainly established by the records.

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*That patent applications are filed based on conceptions partly or wholly not yet in hardware is common knowledge. The whole legal doctrine of constructive reduction to practice is concerned mainly with this sort of situation. Indeed, Knoedler testified to one disclosural deviation of the patent application from what he had requested (T. 483).

Even though in a proper case an abandoned patent application may convincingly corroborate other evidence (*Smith* v. *Hall*, 301 U. S. 216, 227 [1937]); to give it controlling force would be to violate the rule that an abandoned patent application is not prior art. *Milburn Co.* v. *Davis Co.*, 270 U. S. 390, 402 (1926).

The primary witness was Mr. Fred Knoedler, the putative prior inventor. At first he freely testified from memory that he had made up six sets of suspension devices in the critical period, and all at about the same time (T. 445); that in his first installation, in his 1949 Packard, he got squeaks (T. 411), and cured this with a plastic sleeve made from material he got in Chicago (T. 406); that all six sets were so (T. 414), as well as generally similar (T. 446); and that one of the sets had gone to Robertson (T. 421), while another had gone to Truedson. It later turned out that Robertson's device not only had no sleeve (T. 477), but because of certain castings on it could not have been made prior to 1956, as Mr. Knoedler admitted (T. 481, 518). Mr. Truedson testified the device he got had no sleeve (T. 921). The only sleeved device actually found was not only thought by Mr. Knoedler to be one dating from after the critical period (T. 820-1), but turned out to have a rubber (not plastic) sleeve (T. 832), whereupon Mr. Knoedler testified that the six sets had rubber sleeves (T. 832).

Before he finished, Mr. Knoedler himself made clear he had absolutely no confidence in his memory.* Neither he nor any other witness showed any real confidence in his memory alone.**

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*"The only way I can verify [one of the asserted six installations] would be from the records [T. 815]." Again: "I can't remember that far back. If you can't take the records, why, that is as far as I know [T. 398]."

**Expressions so appeared over and over. T. 397, 398, 400, 405, 408, 411, 413, 417, 419, 421, 424, 425, 426, 437, 457, 468, 469, 471, 475, 481, 486, 515, 516, 527, 540, 565, 577, 580, 583, 584, 621, 815, 833, 846, 858, 863, 887.

Reasons for Granting the Writ

Writ should be granted because:

a. petitioner's patent has been invalidated by a decision in conflict with this Court's decision in *Eibel Co.* v. *Paper Co.*, 261 U. S. 45 (1923);

b. it is of public importance to clarify that the statutory requirement of unobviousness is concerned with the character of the inventor's real-life conceptual contribution, not with whether physical devices animated by his conception are more or less similar to what was old, and in this connection to clarify the import of *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545 (1938) on this frequently recurring point; and

c. the decision below is in conflict, as to standard of proof of prior use and knowledge, with a line of decisions of this Court including *The Barbed Wire Patent*, 143 U. S. 275 (1892).

Unobviousness Must Turn on Quality of Conception

1. History and analysis have made clear that any step forward, of the practical sort with which patents are concerned, is characterized both by a conception (which has often been characterized as the mental part of invention) and by physical embodiments (for example, actual suspension devices) animated by the conception.

2. It is well settled, as a matter of law, that whether or not the judicially evolved (now codified in 35 U. S. C. § 103, supra 2) requirement of unobviousness (also called "invention") is met turns wholly on the stature of the conception. Whether or not the embodiments are closely

similar to prior art devices bears no necessary relation to whether or not the animating conception involved was unobvious. Thus, in the leading case *Eibel Co.* v. *Paper Co.*, 261 U. S. 45 (1923), this Court (reversing) upheld a patent in which the embodiments, paper-making machinery, differed from previous ones only in having one end raised a few extra inches. For this change, small as it was, implemented an unobvious new papermaking conception of great practical importance.

3. However difficult it may be to decide whether a particular conception was, when made, unobvious, no room remains for doubt that unobviousness should be assayed in the conception, not the embodiment. The rule implemented by *Eibel* has been discussed with his usual analytical force in a series of opinions by Judge Learned Hand. Thus, in *Gillman* v. *Stern*, 114 F. 2d 28, 30 (2 Cir. 1940), cert. den'd 311 U. S. 718, he said:

> "If . . . an old article must be physically changed, even slightly, . . . the statute [i.e., the parts of it concerned with "anticipation" or "novelty", now 35 U. S. C. § 102] is satisfied. In that case the only question open is whether the discovery of the new use demands enough original thought to be deemed an invention [i.e., is "unobvious" within what is now 35 U. S. C. § 103]. [T]he ingenuity needed for the new conception, not the amount of physical readjustment, is the test of a valuable 'discovery.'"

Other opinions of Judge Hand to this effect were in *Old Town Ribbon & Carbon Co.* v. *Columbia R. & C. Mfg. Co.*, 159 F. 2d 379, 382 (2 Cir. 1947); *H. K. Regar & Sons* v. *Scott & Williams*, 63 F. 2d 229, 231 (2 Cir. 1933); and *Traitel Marble Co.* v. *U. T. Hungerford Brass & Copper Co.*, 18 F. 2d 66, 68 (2 Cir. 1927).

The Lower Courts' Overriding Misconception of Law

4. Unfortunately, the temptation to equate similarity of structure with statutory obviousness seems pervasive. That it happened here seems plain. Thus, at a time when the District Court was "not impressed with most of these patents as prior art" (T. 1050; supra 3, footnote), and regarded as "very impressive" both the failure of the numerous earlier workers to hit on the device (T. 1112) and its enormous commercial impact when introduced (T. 1114), it said (T. 1051, 1112):

> "I have one great difficulty in life, and that is that I have a tendency to judge other people's standards by my own. And I am very exacting with myself. And maybe I am too exacting on other people in their standards, and for that reason I am wondering where the invention is, counsel.
>
> * * *
>
> "[Y]ou know, I am beginning to believe that many of us should leave this legal field and get into this field of—it is amazing what fine additions can be made after so many years—to me some of these things are so obvious."

That the Court of Appeals was similarly oriented is particularly well illustrated by the group of prior art patents it independently chose as grounds for its conclusion of obviousness (App. ix-x). Not one included a sleeve remotely related to Mr. Walker's conceptual contribution*: their only relationship to the Walker device lay in certain structural similarities.

*For example, one patent cited (MacPherson, App. ix) to show a "sleeve" taught use of a bellows for sealing (Ex. 54, MacPherson 2,624,592, col. 4, lines 47-50). Where the language quoted by the Court of Appeals as to this patent (App. ix) came from is not clear, but it did not come from the patent.

As Reflected in Its Unsound Treatment of the Evidence of Prior Efforts with Failure

5. In *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381 (1909), this Court said in upholding a patent:

> "It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

And in *The Barbed Wire Patent*, 143 U. S. 275, 283 (1892):

> "It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of the diamond shape prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp."*

Yet, consistently with their emphasis on structural similarity and inconsistently with an important practical measure of conceptual unobviousness, the courts below in their

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*In *B. G. Corporation* v. *Walter Kidde & Co.*, 79 F. 2d 20, 22 (2 Cir. 1935), the Court said through Judge Learned Hand:

> "In the case at bar it seems to us that the evidence is at hand to show that Paulson's combination was beyond the scope of even the most skilled routineers. The record is peppered with a score of patents upon spark-plugs distributed more or less evenly over more than fifteen years."

opinions gave no heed to the really unusual amount of effort in the area, without hitting on what Mr. Walker did, as evidence of such unobviousness.

As Reflected in Its Palpably Erroneous Handling of the Presumption of Validity

6. By its grant of a patent, the Patent Office resolves the issue of unobviousness, and the patent is presumptively valid (35 U. S. C. § 282). It is well settled, of course, that if prior art that should have been considered by the Patent Office was not, the presumption is to that extent diluted or destroyed. Some patents not cited by the Patent Office can always be found, however, and naturally the presumption does not depend on cumulative citation of patent after patent to show that one particular thing was prior in the art; all that is required is that what the Examiner considered be fully representative.* Yet the Court of Appeals was sufficiently carried along toward the conclusion it apparently thought foreordained by structural similarity to conclude, that (App. xiii) even if " 'less pertinent' prior art . . . was not considered by the Patent Office", the "existence of but one pertinent example of unconsidered prior art is . . . sufficient basis to dissipate the presumption of validity. . . ." (The Court made no finding that fully representative prior art had not been considered and listed on the back of the patent, nor was this so.) It might as well be held that wholly cumulative newly-discovered evidence requires a new trial. The Court improperly as a matter of law thus wrote off the presumption of validity that should have been given weight as supporting conceptual unobviousness.

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*E.g., *Babson Bros. Co.* v. *Perfection Mfg. Corporation*, 86 F. Supp. 754, 759 (D. Minn. 1949).

As Influenced by Misunderstanding of *Lincoln Engineering*

7. The Court of Appeals began its own treatment of the issue of unobviousness with these remarks (App. vi):

> "We think what was said by Judge Pope in his concurring opinion in Bergman v. Aluminum Lock Shingle Corp. of America, 9 Cir. 1957, 251 F. 2d 801 at 809, is applicable here:
>
> > "'In this case there was no patentable invention for the simple reason that it comes precisely within the language of Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp., 303 U. S. 545, 549, 58 S. Ct. 662, 664, 82 L. Ed. 1008: "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention." The quoted statement is a rule of law. It sets a legal standard or test of invention. For failure to meet this legal standard appellee must fail. Thus we determine that there is no invention here as a matter of law.'"

The bare language quoted from *Lincoln Co. v. Stewart-Warner Corp.* can be read to encourage a focus on structural similarities. It can be read, too (and the Court of Appeals so read it), to state a brass-bound sweeping rule of law as to what conceptions are sufficiently unobvious to qualify as inventive. In context, as in common sense, it should not be read in either way. *First*, the quoted language was used in connection with this Court's assumption that a portion of the combination claimed was *per se* inventive (p. 549), and (as well illustrated in the opinion's last sentence, p. 552) was an aspect of an early legal implementation of the policy against tying unpatentable components to patentable, a

policy since implemented with perhaps greater precision and control by techniques worked out in, e.g., *Mercoid Corp. v. Mid-Continent Co.*, 320 U. S. 661 (1944). *Second*, this Court cannot have meant to imprison in such a simple form of words so elusive an issue as the unobviousness of a conception. Nor may anything in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147 (1950) be so read: of the language above quoted from *Lincoln Engineering* the Court said (p. 151) that the "negative rule . . . was [there] condensed about as precisely as the subject permits"; it had already noted there was no "precise and comprehensive definition" (p. 150). As Judge Learned Hand put it in *Safety Car Heating & Lighting Co. v. General Elec. Co.*, 155 F. 2d 937, 939 (2 Cir. 1946): "No objective standard is practicable; . . . as, for example, whether each of the elements operates in a different way from what it did in other combinations. . . . it is their cooperation that produces the result, and the value of that cooperation depends upon the sagacity which divined the end and fabricated the means."*

8. Beyond all this, no finding was (or could properly have been) made that the functions performed by Walker's sleeve (*supra* 7) in his device were not, in part or as a whole, new with respect to functions performed by any sleeve in any plainly prior art device.

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*In *Weston Electrical Instrument Corp. v. Dejur-Amsco Corp.*, 133 F. 2d 778, 780-1 (2 Cir. 1943), he said:

> "As we have very often said, we put more reliance in deciding the issue of invention upon the history of the art than upon any tests which can be stated in general terms; indeed, there are, we think, none such which perceptibly help to a solution.
>
> * * * *
>
> "In every case the issue is whether a person acquainted with what had already been done, and endowed with no more than average imagination would have conceived the combination; and, while so to state the problem is not much of a step towards its answer, at least it clears the path of false directions."

Infected Conclusions

9. A number of considerations in addition to prior efforts without success and presumption of validity tend strongly to indicate the unobviousness of Mr. Walker's conception. These include, on well-settled authority, the considerable commercial success, the substantial acquiescence in the patent by taking of licenses in the industry, the views of the jury members in *Champ-Items,* and others. Cutting oppositely, although far from conclusively, is the fact that such a sleeve was independently conceived by Mr. McIntyre (T. 349), and perhaps arguably other circumstances. What is plain, however, is that in reaching its conclusion of obviousness the Court below viewed the evidence from a legally unsound standpoint, so that even assuming (contrary to truth) the same conclusion could properly be reached from the legally sound point of view, petitioner has nevertheless been denied any judgment rooted in the governing rules of law. The result reached is as infected as a discretion exercised on the basis of misunderstanding of law, an exercise insupportable even assuming that another exercise, on proper understanding, might produce the same result.

Evidence of Knoedler Prior Use and Knowledge Failed to Meet Standard of Proof Applicable As Matter of Law

10. In finding adequate proof of prior use and knowledge that concededly might be reasonably taken as supporting a conclusion of lack of prior use and knowledge, proof thus not "clear and convincing", the Court of Appeals permitted a standard far below that over and over imposed by this Court. E.g., *The Barbed Wire Patent,* 143 U. S. 275, 284-285 (1892):

> "We have now to deal with certain unpatented devices, claimed to be complete anticipations of this

patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be *clear, satisfactory and beyond a reasonable doubt.* Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. * * * The doctrine was laid down by this court in *Coffin* v. *Ogden*, 18 Wall. 120, 124, that 'the burden of proof rests upon him,' the defendant, 'and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment[*]; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view.' This case was subsequently cited with

[*] There was no non-memory evidence that sleeved Knoedler devices were concluded to be satisfactory and thus not irrelevant as "abandoned experiments", even assuming their relevant existence, and there was considerable evidence supporting a contrary conclusion.

approval in *Cantrell v. Wallick*, 117 U. S. 689, 696, and its principle has been repeatedly acted upon in the different circuits. *Hitchcock v. Tremaine*, 9 Blatchford, 550; *Parham v. American Button-Hole Machine Co.*; 4 Fisher, 468; *American Bell Telephone Co. v. Peoples' Telephone Co.*, 22 Fed. Rep. 309."

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the writ should be granted, to the end that facts may be viewed in the light of the properly applicable rules of law.

Respectfully submitted,

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APPENDIX A

Opinion of the United States Court of Appeals for the Ninth Circuit, 332 F. 2d 473 (May 22, 1964)

Before BARNES, MERRILL and DUNIWAY, Circuit Judges.

BARNES, Circuit Judge:

This appeal is from a final judgment in a patent infringement action. 28 U.S.C. § 1338(a) and (b). Jurisdiction here rests upon 28 U.S.C. § 1291.

Two patents are involved, United States Patent No. 2,896,938 and No. 2,912,235 (hereinafter referred to as the '938 patent and the '235 patent, respectively).

Appellant sued for contributory infringement and active inducement to infringe '938 and Claim 14 of '235. Appellee denied infringement, and validity of the patents, and counter-complained for unfair competition and harassment. By pre-trial order, only Claims 2, 3 and 4 of '938 and Claim 14 of '235 were in suit.

After trial, the court below ordered judgment for defendant on the complaint; declared the patents invalid, and ruled defendant had failed to sustain the counter-claim for unfair competition and attorney's fees.

A motion for new trial was made by appellant on the ground of newly discovered evidence; and by stipulation, the evidence (a deposition) was admitted in evidence. The motion for new trial was dismissed. After reconsideration, the trial judge reaffirmed his original decision.

The question of infringement was not ruled on below, because of the trial court's view of invalidity.

I

The patents and claims in suit relate to a simple suspension device, commonly known as a shock absorber. Its

uniqueness lies in a sleeve placed within the coiled spring surrounding the shock absorber.[1] Patent '938 was described by the court below in Finding of Fact 12 as follows:

> "12. Patent No. 2,896,938 in suit relates to an auxiliary vehicle suspension device that includes a conventional tubular shock absorber disposed within a coil spring. The shock absorber consists of two

1. The claims of the '938 patent in suit read as follows:

> "2. In a suspension device, a hydraulic direct-acting tubular shock absorber having relatively movable telescopic parts, a coil spring disposed substantially concentrically with respect to said shock absorber, means on one of said relatively movable shock absorber parts engaging and supporting one end of said coil spring, means on the other of said relatively movable shock absorber parts engaging and supporting the opposite end of said coil spring, and an elongated nonmetallic resilient tubular spacer sleeve fitted over said shock absorber and resisting lateral movement of said coil spring so that the coil spring is maintained in substantially concentric relationship with respect to said shock absorber.
>
> "3. In a suspension device, a hydraulic direct-acting tubular shock absorber having relatively movable telescopic parts, a coil spring sleeved over said shock absorber, the inside diameter of said spring being larger than the outside diameter of said shock absorber, an elongated nonmetallic tubular spacer sleeve fitted over said shock absorber and disposed in the space between said shock absorber and said coil spring, said spacer sleeve resisting lateral movement of the coil spring so that said shock absorber and coil spring are maintained in spaced substantially concentric relationship.
>
> "4. In a suspension device, a hydraulic direct-acting tubular shock absorber including relatively movable telescopic parts, one of said parts including an elongated body member and the other of said parts including a rock guard disposed exteriorly of and in concentric relation with said body member, a coil spring disposed substantially concentrically around said shock absorber, means on one of said relatively movable shock absorber parts engaging and supporting one end of said coil spring, means on the other of said relatively movable shock absorber parts engaging and supporting the opposite end of the said coil spring, and an elongated nonmetallic tubular spacer sleeve fitted over said shock absorber rock guard and resisting lateral movement of said coil spring so that said coil spring is maintained in substantially concentric relationship with respect to said shock absorber."

parts, one being a body portion 10 and the other a piston and rod. The piston rod telescopes into the body portion when the shock absorber is compressed. The piston rod is connected at its upper portion to a depending dust guard 11 having an outwardly flaring flange 11a at its bottom. The ends of the coil spring are supported with respect to the relatively movable parts of the shock absorber. The specification of this patent recites 'A sleeve 86 of non-metallic rubber or fiber material fits between the adaptor 80 and the flange 11a of the dust guard 11'. *It is the addition of this sleeve 86 to the prior art combination of a tubular shock absorber disposed within a coil spring that provides the basis for the assembly recited in Claims 2, 3 and 4 of Patent No. 2,896,938.*" (Emphasis by appellee.)

The claimed uniqueness in the second patent (Claim 14 of '235) is the installation of the device above described in a "sea-leg" manner, i.e., at an angle or incline, instead of straight up and down; so as to resist lateral movement or sidesway, and combine a vertical smoothness.[2]

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[2]Claim 14 of the '235 patent reads as follows:

"14. In a rear suspension system for an automotive vehicle, the combination comprising a spring assembly and an unsprung assembly, said unsprung assembly comprising a rear axle and a pair of laterally spaced ground engaging wheels mounted on said axle, a main suspension spring disposed adjacent each said wheel and connected with said sprung and unsprung assemblies so as to act in a general vertical direction to yieldably support said sprung assembly on said unsprung assembly for relative vertical movement, a pair of angularly extending auxiliary coil springs, disposed between said sprung and unsprung assemblies, an angularly disposed hydraulic direct acting tubular shock absorber extending through each of said coil springs, each of said shock absorbers including relatively moveable telescopic parts, means on each of said shock absorber parts engaging and supporting the opposite ends of the adjacent coil spring so that telescoping and extension of said shock absorber parts and compression and extension of said coil springs occurs simultaneously, one of said parts of each of said shock absorbers being connected with said rear axle of said unsprung assembly adjacent one

The heart of the invention claimed in '938 is the "non-metallic, tubular spacer sleeve." Being between the inner hydraudlic shock-absorber and the outer concentric coil spring, it is claimed (in Claim 2) that it maintains substantial concentric relationship between the absorber and the coil spring, and resists lateral movement of the coil spring. This sleeve is claimed to prevent noise (if made, for example, with rubber), prevent excessive "buckling" or thrashing of the spring, and prevent wear and tear between the metal of the shock absorber and the metal of the coil spring.

II

The errors of the trial court were alleged to have been:

(1) In holding the prior art was such that the subject matter of Claims 2, 3 and 4 of '938 was *obvious* to one having ordinary skill in the automobile vehicle suspension art.

(2) In finding the usual presumption of validity of a patent was dissipated because certain *prior art* was not considered by the Patent Office in connection with the prosecution of the patent in suit.

(3) In finding the combination of tubular shock absorber, coil spring and rubber sleeve was a mere *aggregation of old elements*, without change in their function, and hence without invention.

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of said main suspension springs, the other part of each of said shock absorbers being connected with said spring assembly laterally inwardly of the connection to said unsprung assembly so that each said shock absorber and the adjacent coil spring extends angularly between said sprung and unsprung assemblies so as to provide a lateral component to resist lateral sway of said sprung assembly relative to said unsprung assembly while simultaneously adding a vertical component to the resistance to vertical movement provided by said main springs between said sprung and unsprung assemblies."

(4) In finding the Knoedler Patent *anticipated* '938.

(5) In finding *prior use* by Knoedler in 1953 of the device.

(6) In finding the Knoedler device was *reduced to practice* before the filing date of the '938 patent, i. e., prior to May 6, 1954, and was not "abandoned."

(7) In holding that the Knoedler literature disbursed in 1953 discloses and completely anticipates the invention claimed in 2, 3 and 4 of '938.

(8) In not finding contributory infringement and actively induced infringement in appellee with respect to '938.

(9) In holding the same obviousness existed as to Claim 14 of '235 as was found in (1) above as to '938.

(10) In holding the same regrouping of *old elements* without change of function with respect to '235 as was found in (3) above with respect to '938.

(11) In finding the same *anticipation* by Knoedler with respect to '235 as was found with respect to '938 in (4) above.

(12) In finding the same *reduction to practice* by Knoedler with respect to '235 as was found with regard to '938 in (6) above.

(13) In finding the same disclosure and anticipation in the Knoedler literature with respect to '235 as existed with respect to '938 in (7) above.

(14) In failure to find the infringement and actively induced infringement with respect to '235 as was claimed with respect to '938 in (8) above.

III

Appellant seeks to establish these errors: (a) the lack of obviousness (b) by reference to unsolved problems in the art, (c) the commercial success of appellant's device, (d) the number of licenses appellant has issued, (e) the alleged slavish copying by appellee of the patented device, (f) the simplicity of the device, (g) that the patent office considered "the most pertinent" prior art, (h) that Knoedler's device had not been reduced to practice, and had been abandoned, (i) that much evidence re use, construction, testing, operation and disclosure of the Knoedler device was confusing and contradictory.

What appellant desires us to do with respect to the obvious lack of invention found in appellant's device is to substitute our judgment for that of the trial court. This we cannot do if it involves a finding of fact. (Rule 52(a).) But the finding of validity i. e., whether or not there is invention, is, of course, a matter of law, not of fact. We think what was said by Judge Pope in his concurring opinion in Bergman v. Aluminum Lock Shingle Corp. of America, 9 Cir., 1957, 251 F.2d 801 at 809, is applicable here:

> "In this case there was no patentable invention for the simple reason that it comes precisely within the language of Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp., 303 U.S. 545, 549, 58 S.Ct. 662, 664, 82 L.Ed. 1008: 'The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention.' The quoted statement is a rule of law. It sets a legal standard or test of invention. For failure to meet this legal standard appellee must fail. Thus we determine that there is no invention here as a matter of law."

Cf. also: Pressteel Co. v. Halo Lighting Products, Inc., 9 Cir. 1963, 314 F.2d 695, 697-698, and cases cited therein.

Merely to label the trial court's determination as "subjective hindsight" does not determine the issue. We agree thoroughly that subjective hindsight is not a proper test. Nor does the simplicity of a device negate an invention. Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co., 1944, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721.

Having said that much, we must cross the next hurdle: Was subjective hindsight applied here to this very simple device? It can be argued with some truth the more simple the device, the more difficult it may well be to invent it. Yet a device does not become invention merely because it is simple any more than it does because it resembles a Rube Goldberg creation or other apparatus of considerable complexity.

Counsel for appellant has assumed that the trial court failed to look at the various objective criteria of invention. We discuss them in turn:

(a) "The long felt need for the invention."

The court, in its wisdom, found the prior art anticipated this device—in that it was admittedly a "combination patent" of old elements, without change in function.

The hydraulic tubular piston type direct action shock absorber was defined in Finding 12 to be conventional. The appellee, Superior Industries, Inc., does not sell shock absorbers; merely a kit with springs, clamps and sleeves to "convert" the conventional device. The coiled surrounding spring was old in the art. McIntyres Patent No. 2,874,955.[3]

[3] Appellant makes the following explanation re patent No. 2,874,955:

> "Two of Plaintiff's employees, namely, B. D. McIntyre and W. D. McIntyre, filed a patent application on Plaintiff's 'Load-Leveler' device in 1957, and this patent application matured into U. S. Patent No. 2,874,955 (hereinafter referred to as 'McIntyre '955 Patent'). For several years prior to 1957, a Mr. Brooks Walker of San Francisco, California, had been trying to interest Plaintiff in several devices or inventions which he had made, some of which related to overload suspension arrangements. From time to time, Mr. Walker discussed

filed by plaintiff's employees on June 11, 1957, came to the conclusion that "many auxiliary or helper spring units have been developed and designed for use on vehicles. These helper springs have taken the form of coil springs, flat leaf type springs, air bags, etc. * * *" (Plaintiff's Ex. 42, File

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his various inventions with personnel of Plaintiff company and in 1959, after the McIntyre '955 Patent issued, Mr. Walker again approached Plaintiff company and advised Plaintiff's attorney that he had two patent applications which were filed in 1954 which he thought entitled him to patent protection which would cover and dominate Plaintiff's 'Load-Leveler' units. Mr. Walker furthermore, in accordance with approved Patent Office practice, copied claim 7 of McIntyre '955 Patent and inserted it in a patent application he had pending in the Patent Office and asked the Patent Office to declare an interference.

"The Patent Office did declare an interference and Plaintiff conceded that Walker was the first inventor and that this patent claim properly belonged to Walker. As a result the Walker '235 Patent issued and claim 14 of this patent is identical to claim 7 of the McIntyre '955 Patent. As a result of Walker's priority, Plaintiff disclaimed claim 7 from the McIntyre '955 Patent.

"In addition, Walker after studying the file wrapper of the McIntyre '955 Patent found that claims 13 and 14 of the McIntyre patent application had not issued in the McIntyre '955 Patent because of the possible declaration of an interference in the Patent Office. Walker, because of his priority then copied claims 13 and 14 from the McIntyre application and inserted the claims in his patent application, serial number 769,967, which was a divisional application of his original patent application, serial number 427,927, filed May 6, 1954. It is clear from the various certified file wrappers (Ex. 42, 45, A and B) that the same Patent Office Examiner, a Mr. W. B. Wilbur, handled the prosecution of the patent application which resulted in the McIntyre '955 Patent, the original Walker application, and the Walker divisional application which resulted in the Walker '938 Patent and that claims 2 and 3 of the Walker '938 Patent in suit are identical with the aforementioned two claims which were in the McIntyre patent application. As a result of the aforementioned situation, Plaintiff purchased the Walker patent applications and the resulting '938 and '235 patents in suit and has paid substantial royalties to Walker on all 'Load-Leveler' suspension units sold by Plaintiff since June 1, 1950. (See agreement Ex. 21 and R. 303-307.)" (pp. 9-11, Appellant's Brf.)

Wrapper, p. 3.) Coil springs are shown in the following cited pre-existing patents:

Dahlstrom	1,471,474	October 23, 1923
Reese	2,733,058	January 31, 1956
MacPherson	2,624,592	January 6, 1953

and perhaps

Carena (Italy)	466,870	November 20, 1951

(*Cf.* McIntyre File Wrapper, p. 38.)

Significantly, the same McIntyre file wrapper states (pp. 39-40):

> "As to the particular rate of the spring and the particular calibration of the valves, these are merely matters of arbitrary choice or mechanical design and have no patentable significance."

and:

> "Merely to select a particular spring rate and to calibrate the shock absorber valves as recited in this claim involves nothing more than the exercise of routine engineering design and is not inventive."

These observations were not made by the patent examiner about the patents in suit, but are as applicable to them as to any device showing a similar combination of commonly known members.

The elongated tubular spacer (made nonmetallic by amendment subsequent to the original patent application) is similar to the flexible sleeve (59) of MacPherson, "sleeved over tube 25, [preventing] spring 64 from contacting tube 25."

Magrum, No. 2,640,693, of June 2, 1953, likewise showed a rubber sleeve (60) located between a coil spring and shock absorber part.

Padgett, No. 2,092,259, of September 7, 1937, showed a rubber sleeve (60) between a dust guard and a cylinder of a shock absorber.

We agree with the trial court that the prior art anticipated and demonstrated the existence of the shock absorbers, the coil springs, and the sleeve, of various non-metallic substances; and that their combination was not invention.

(b). Appellant urges as its second objective test the immediate success of the device:

(1) $26,000,000 worth sold from May 1957 to November 1962;

(2) Appellant's licensees sold $1,000,000 worth of patented devices and paid $60,000 in royalties in twenty-nine months;

(3) Appellee's sale of over $500,000 worth of the devices covered by the patents in suit.

This is all valid evidence of success, but it does not necessarily prove such success was proximately *and solely* caused by the genius of the invention.

It has already been pointed out appellee did not sell the entire patented device, merely kits containing articles similar to those of the patent sleeve, clamps and coil. It is also plainly evident that appellant carried on an aggressive, forceful campaign to license any and all shock absorber manufacturers who could be induced to buy a license,[4] and

[4] Plaintiff's Ex. 22, dated July 1, 1960, GorDag Industries, Inc.
Plaintiff's Ex. 24, dated July 1, 1960, Champ-Items, Inc.
Plaintiff's Ex. 28, notarized on August 8 and 9, 1960, dated July 1, 1960, Perfection Automotive Products Corp.
Plaintiff's Ex. 29, notarized July 12 and 18, 1960, dated July 1, 1960, Medco Stamping Co.
Plaintiff's Ex. 30, notarized July 18 and August 2, 1960, dated July 1, 1960, T. & R. Manufacturing Co.
Plaintiff's Ex. 32, notarized November 16 and December 2, 1960, dated July 1, 1960, Larry Lewis Co.
Plaintiff's Ex. 38, notarized October 19 and 26, 1962, dated October 1, 1962, Crown Spring Co.

to obtain consent judgments from the same or similar manufacturers, who were willing (or who might prefer, for one reason or another) to avoid litigation.[5] One judgment was recovered against Champ-Items, Inc. for $1.00 damages.[6]

We also note that apparently all the foregoing consent decrees[7] awarded no costs, no attorney's fees and no damages. In Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., W.D. Tenn. 1961, 204 F.Supp. 249, the patent was held invalid in view of prior art and prior public knowledge and use of the Knoedler devices hereinabove mentioned.[8]

Thus a great deal could be surmised by one knowledgeable in patent law as to just how much was proved by consent decrees and licenses other than that the parties thereto usually were of a different economic level. We assume no facts, but we are realistic enough not to blind ourselves to the fact that many patents are "built up" by the whole-

[5]Plaintiff's Ex. 23, dated July 18, 1960, GorDag Industries Inc.
Plaintiff's Ex. 27, dated July 29, 1960, Champ-Items, Inc.,
Plaintiff's Ex. 31, filed August 9, 1960, T. & R. Manufacturing Company.
Plaintiff's Ex. 33, filed December 7, 1960, Larry Lewis Co.
Plaintiff's Ex. 34, undated, Sumner's Automatives Inc.
Plaintiff's Ex. 35, dated December 23, 1959, H. J. Frye
Plaintiff's Ex. 36, filed April 4, 1960, Schrager Eng. Co.
Plaintiff's Ex. 37, dated January 5, 1960, Donald Osterhoudt

[6]Plaintiff's Ex. 25, dated March 19, 1960.

[7]With the exception of (1) Monroe Auto Equipment Co. v. Champ-Items, Inc., where $1.00 damages were awarded by a jury (Plaintiff's Ex. 25), and (2) Monroe Auto Equipment Co. v. H. J. Frye Co., dba H. J. Frye Auto Supply, where defendant consented to pay five per cent of the net profits from the sale of the one (only one) "unfringing" unit sold (Plaintiff's Ex. 35).

[8]The judgment in that case was vacated and remanded on other grounds, 305 F.2d 375, on remand was again found invalid, 214 F.Supp. 704; and such invalidity was affirmed on appeal, Monroe Auto Equipment Company v. Heckethorn Manufacturing and Supply Company, 6 Cir., 332 F.2d 406, decided May 14, 1964. (See particularly slip opinion, pp. 8 to 16, where the same points herein made by appellant are determined adversely to it.)

sale use of consent decrees, without the merits of the invention ever having been tested in the courts.

We have repeatedly held that commercial success, however great, is but one factor in proving originality, i. e., invention. We have described it as a "make weight." Pressteel Co. v. Halo Lighting Products, Inc., 9 Cir. 1963, 314 F.2d 695,699; Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp., 9 Cir. 1961, 287 F.2d 228, 230.

Obviously, as appellant concedes, being but one factor, it is not controlling or conclusive on the issue.

(c) The payment of royalties to appellant.

We have discussed the evidence in this case on this subject under (b) above. We do not differ with the rule of law inferentially approved in Pursche v. Atlas Scraper & Eng. Corp., 9 Cir. 1962, 300 F.2d 467, 489, cert. den. 371 U.S. 911, 83 S.Ct. 251, 9 L.Ed.2d 170, reh. den. 371 U.S. 959, 83 S.Ct. 499, 9 L.Ed.2d 507, and expressed in Eibel Process Co. v. Minnesota & Ontario Paper Co., 1923, 261 U.S. 45, 55-56, 43 S.Ct. 322, 67 L.Ed. 523; Campbell v. Mueller, et al., 6 Cir. 1947, 159 F.2d 803, 808-809; Coltman v. Colgate-Palmolive-Peet Co., 7 Cir. 1939, 104 F.2d 508, 511, cert. den. 308 U.S. 598, 60 S.Ct. 129, 84 L.Ed. 500, reh. den. 308 U.S. 637, 60 S.Ct. 178, 84 L.Ed. 529. We hold it good law, but not controlling law on the facts of this case.

(d) Appellant's third objective indicium is appellee's alleged precise copying. "Why doesn't Defendant," asks appellant,[9] "* * * eliminate the rubber sleeve and sell units made like the device disclosed in the prior art such as the French and Italian patents [?]" Defendant answers that it does, that it sells one third of its units without rubber sleeves; and that two of appellant's licensees (Exs. BH and BI) (GorDag Industries and Perfection Motor Products) sell

[9]Opening Brief, p. 25.

their devices without a rubber sleeve, despite their payment of a five per cent royalty for the right to use it.[10]

Thus we agree with the theory expounded by appellant that where there *is* no evasion by even a variation of the details of a patented arrangement, but a precise copying of all details exists, a strong presumption arises that the precise form described by the patented arrangement is, without deviation, inevitably necessary. Yet the facts of this case do not require the conclusion of a precise copying, without material deviation, from what has been above stated.

And the evidence introduced by appellant (Ex. 60 and Rptr's Tr. pp. 1055-1058) of experiments performed without use of a rubber sleeve is at best persuasive, and not controlling.

(e) The simplicity of the device we have touched upon above under "obviousness."

(f) "The patent office considered the most pertinent prior art relied upon by defendant."

The argument is a two-edged sword. It assumes that "less pertinent" prior art existed, and that it was not considered by the Patent Office. The existence of but one pertinent[11] example of unconsidered prior art is not only sufficient basis to dissipate the presumption of validity (Pressteel Co. v. Halo Lighting Products, Inc., supra; Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp., supra), but may render the patent invalid.

In the instant case, urges appellant, "the most pertinent prior art relied on by the defendant is either the same as prior art considered by the Patent Office, or is from non analogous fields having nothing to do with automobile suspension systems."

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[10]GorDag makes a rubberized spring with rubber bonded on the coil (Ex. BH), while Perfection bonds a vinyl coating on the coil (Ex. BI).

[11]We do not need decide whether, if pertinent, it was less or most pertinent.

The district court, says appellant, was apparently misled in this issue, "because the prior arts patents relied on by defendant are not listed at the back of the patents in suit as prior art references of record." This, says the appellant, is not of real consequence, because W. R. Wilbur was the Patent Office Examiner who handled the '938 patent, the original Walker patent application on which '938 was based and the McIntyre patent application which resulted in the McIntyre '955 patent. (Exs. 42, 45 and A.) Thus, says the appellant, he must have known of all prior art.[12]

Our attention is directed to two cases: Otto v. Koppers Co., Inc., et al., 4 Cir. 1937, 246 F.2d 789, cert. den. 355 U.S. 930, 78 S.Ct. 427, 2 L.Ed.2d 420, Mechanical Ice Tray Corp. v. Abraham & Strause, Inc., E.D.N.Y.1940, 31 F.Supp. 938. We find nothing in the second case to support appellant's theory. The Koppers case involved a patent in suit "issued upon an application which was a continuation in part and consolidation of several prior, copending applications," in one of which the alleged prior art *was cited*. The superseding application and the earlier applications were handled by the same examiner. On this state of facts, it could not be said, (held the fourth circuit) that the prior art relied on had not been cited or considered (p. 801). We do not find the facts in Koppers similar in any marked degree to the facts of this instant case.

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[12]Appellant states no particular law is necessary to support this position. We do not agree. The examiner's mind, concerned with many patent prosecutions over a substantial period of time, is no more infallible than a judge's or a trial attorney's. The former cannot remember with certainty, in an opinion on one subject, all the positions he has taken in other cases involving the same legal principles, nor all the cases he has relied on to support his position. Nor can the average attorney, once having finished a case, remember all the cases he cited or considered in a previous case when preparing a new one.

Finding 9 of the district court (Clk's Tr. pp. 89-90) found the following had been urged by defendant below as prior art:

French Patent	No. 1,044,393 (Ex. E)
Italian "	No. 467,071 (Ex. D)
Farmer, U.S. Patent.	No. 2,344,858 (Ex. G)
Chayne, " "	No. 2,159,203 (Ex. L)

1953 English Ford Front Suspension Patent (Ex. BD-1)

Finding 10 of the district court found (a) Exhibits E, D and BD-1 to show the tubular shock absorbers surrounded by a coil spring; (b) Exhibit G to show the rubber sleeve between the coil spring and a tubular metallic element; Exhibit BD-1 to show a rubber sleeve on the shock absorber; not intended to act as a spacer; (c) that the use of rubber between relatively movable metal parts to avoid metal to metal contact is old. (This was admitted by the plaintiff in pre-trial conference.)

Finding 14 found the prior art anticipating '938 was Exhibits E, D, G and BD-1.

Findings 15 to 18 found that the "sea-leg" mounting was old in the art, prior to '235, quoting a reference to such mounting that "most cars have adopted" in the S.A.E. Journal of 1949, and that it was disclosed in the Chayne patent (Ex. L), and that Claim 14 of '235 was anticipated generally by Exhibits L, E, D and Brooks Walker patent No. 2,518,733.

Finding 19 found that none of the patents suggested by the defendant as prior art (and as listed above) had been cited to the patent office.

It is true that the Farmer patent (Ex. G) is a railroad car brake-cylinder device. We agree that this weakens the value of it, as bearing upon the patent in suit, issued in a different field. But all such argument as to what is "most pertinent" fades before the fact of existence of such prior art as was proved; the trial court's determination that it

was not cited; and that it did in fact anticipate the claimed invention in Claims 2, 3 and 4 of '938, and Claim 14 of '235. The presumption of validity based upon the patents' issuance was thus weakened, and created an issue, whether of fact or law or both, decided adversely to appellant which we will not disturb on appeal.

Appellant's argument that the prior foreign art disclosed "unsatisfactory devices" assumes that tests made by defendant with Exhibit 59 ("the actual physical exhibit of the shock absorber and spring unit used in the two foreign patents, Exhibits D and E") establish without contradiction that Exhibits D and E would not "work." But the trial judge did not rest his conclusion on appellant's recreated devices, but on the teachings of the French (Ex. E) and Italian (Ex. D) patents. In other words, the experiments performed by appellant were not as conclusively persuasive on the trial judge as appellant would have us believe.

Appellant's position is that the admitted combination of old elements produced some "difficult to describe" new and useful results, and that we should disregard Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162, which was relied upon by the district court. This we have in the past,[13] and now, decline to do.

[13] As to the point concerning the patentability of a combination of old elements, this court has followed Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162, in many cases, the more recent being: Hutchinson v. Pacific Car & Foundry Co., 9 Cir., 1963, 319 F.2d 756, 760; Aetna Steel Products Corp. v. Southwest Products Corp., 9 Cir., 1960, 282 F.2d 323, 332-333, cert. den. 365 U.S. 835, 81 S.Ct. 804, 5 L.Ed.2d 810; William T. Alvarado Sales Co. v. Rubaloff, 9 Cir., 1959, 263 F.2d 926, 930, cert. den. 360 U.S. 910, 79 S.Ct. 1295, 3 L.Ed.2d 1260; Gratiot v. Farr Co., 9 Cir., 1956, 237 F.2d 940, 941, cert. den. 352 U.S. 1026, 77 S.Ct. 592, 1 L.Ed.2d 597; Coleman Co. v. Holly Manufacturing Co., 9 Cir., 1956, 233 F.2d 71, 78-79 cert. den. 352 U.S. 952, 77 S.Ct. 326, 1 L.Ed.2d 243; Hunter Douglas Corp. v. Lando Products, 9 Cir., 1954, 215 F.2d 372, 375; Kwikset

We finally come to the Knoedler and Truedson hydro shock devices—claimed to be prior art—which anticipated appellant's claimed invention.

Findings 20 to 26 made by the court below read as follows:

> "20. Plaintiff was limited to a date of alleged invention of May 6, 1954 for Patent No. 2,896,938 in suit and a date of alleged invention of September 30, 1954 for Patent No. 2,912,235 in suit, i.e. the filing dates of said patents, since plaintiff failed to provide evidence of any earlier dates. Defendant produced clear and convincing proof that prior to these dates a device embodying the alleged invention of said patents was known and used in this country by Fred E. Knoedler and Harry Richard Knoedler both of Streator, Illinois. Additionally, the alleged invention of Claim 14 of Patent No. 2,912,235 was known and used in this country by John D. Truedson now of Phoenix, Arizona. Fred E. Knoedler constructed several pairs of so-called 'Hydro Shock' booster springs as early as the Spring of 1953. These devices included a tubular shock absorber surrounded by a coil spring, with a rubber sleeve carried by the shock absorber and interposed between the shock absorber and the spring to resist lateral movement of said spring and prevent metal-to-metal contact and noise. Such Hydro Shock devices would have

Locks v. Hilligren, 9 Cir., 1954, 210 F.2d 483, 486, cert. den. 347 U.S. 989, 74 S.Ct. 852, 98 L.Ed. 1123 and 348 U.S. 855, 75 S.Ct. 78, 99 L.Ed. 673, reh. den. 348 U.S. 852, 75 S. Ct. 19, 99 L.Ed. 671.

In Pressteel Co. v. Halo Lighting Products, Inc., 9 Cir. 1963, 314 F.2d 695 at 698, we said:

"The test of invention is, as set forth in the case of Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U.S. 84, at pages 89 and 90 [62 S.Ct. 37, 86 L.Ed. 58]:

"'* * * [that] more must be done than to utilize the skill of the art in bringing old tools into new combinations (cases cited). * * * We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. * * * [T]he device must not only be "new and useful," it must also be an "invention" or "discovery."'"

infringed Claims 2, 3 and 4 of Patent No. 2,896,938 if said devices were made after said patent issued. A pair of these Hydro Shock booster spring devices were mounted in a 'sea-legs' fashion on the rear suspension of a 1949 Packard automobile owned by Fred E. Knoedler in the Spring of 1953. When so installed the assembly of said Hydro Shock devices on the rear suspension of this automobile would have infringed Claim 14 of Patent No. 2,912,235 if such assembly had been made after said patent issued. Hydro Shock devices operated satisfactorily and proved to be practical in supporting the rear end of the Fred E. Knoedler automobile whereon they were installed.

"21. A pair of similar Hydro Shock booster springs made by Fred E. Knoedler and incorporating a rubber or plastic sleeve around the shock absorber were installed on the 1949 Chevrolet of Harry Richard Knoedler in a 'sea-leg' fashion during the Summer or Fall of 1953. John D. Truedson installed a pair of the Fred E. Knoedler Hydro Shock booster springs on his 1951 Oldsmobile in about August of 1953. It was not clear that Truedson's Hydro Shock booster springs included a rubber sleeve. However, it was clearly established that the shock absorbers on Truedson's automobile were mounted in a sea-leg fashion and were encircled by a coil spring. The Hydro Shock devices installed on the automobiles of Harry Richard Knoedler and John D. Truedson operated satisfactorily.

"22. No attempt was made to keep the Knoedler Hydro Shock booster spring devices secret. These devices as installed on the 1949 Packard of Fred E. Knoedler were shown to members of the public including employees of Knoedler Manufacturers, Inc. of Streator, Illinois, employees of Beckman Motor Company of Streator, Illinois and the manager of Sig Automotive Parts, Streator, Illinois. Additionally, Knoedler Manufacturers, Inc. advertising (Exhibit AF and Exhibit AG) clearly disclosing the

construction of the Hydro Shock booster springs and the sea-leg mounting thereof on the rear suspension of an automobile was sent out to various automotive parts distributors in the Fall of 1953.

"23. Fred E. Knoedler filed U. S. Patent Application No. 377,880 on September 1, 1953 (Exhibit AL), which application was later forfeited. This application discloses the Hydro Shock booster spring in detail and includes all of the elements which make up the aggregation of Claims 2, 3 and 4 of Patent No. 2,896,938. Figure 1 of this patent application shows the Knoedler device mounted in a 'sea-leg' position on the rear suspension system of an automobile. Hence, the disclosure of this application fully corroborates the other evidence relative to the construction of the Hydro Shock booster spring devices and the mounting thereof in a 'sea-leg' fashion on an automobile rear suspension.

"24. The knowledge and use of the Fred E. Knoedler Hydro Shock device by others in this country prior to the alleged dates of invention of both patents in suit was clearly established by the evidence. Accordingly, said Knoedler device is a complete anticipation of Claims 2, 3 and 4 of Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 under the provisions of 35 U.S.C. § 102(a).

"25. Knoedler Manufacturers, Inc. commencing with the Fall of 1953 attempted to market the Hydro Shock device. This attempt was unsuccessful because it was not possible to obtain shock absorbers at a reasonable price and because the Hydro Shock device was outside the farm equipment field in which Knoedler Manufacturers, Inc. was working. It was clearly established that the Hydro Shock devices used by Fred E. Knoedler, Harry Richard Knoedler and John D. Truedson operated satisfactorily and proved effective in supporting the rear end of a heavily loaded automobile. The design of the first Hydro Shock devices was not frozen and Fred

E. Knoedler later developed a second type of device utilizing a coil spring that was clamped to the opposite ends of a shock absorber, but not utilizing a rubber sleeve. The Knoedler Hydro Shock device was reduced to practice and it was not an abandoned experiment.

"26. Within the week preceding August 22, 1953 John D. Truedson sold his 1951 Oldsmobile with the pair of Hydro Shock devices still mounted in a 'sea leg' fashion around the rear shock absorbers thereof. Truedson's automobile was sold to Jacobson Trailer Sales in Fergus Falls, Minnesota. Since this sale was made more than one year prior to the date of filing of Patent No. 2,912,235, i.e. September 30, 1954, Claim 14 of said patent is invalid in accordance with the provisions of 35 U.S.C. 102(b)." (Clk's Tr. pp. 93-96).

We need not analyze in great detail the conflicting claims of appellant and appellee as to what the evidence is in the record with respect to the Knoedler and Truedson shock devices. Knoedler, for example, testified he used Exhibit AT in 1953, including the rubber sleeve. His testimony was corroborated by his two sons, by his patent application (Ex. AL), his drawings, his catalog sheet (Ex. AF) and his price sheet (Ex. AG). Photographs of these "shocks," with attachment in "sea-leg" fashion, were taken prior to August 7, 1953. There is evidence of installation and public use of these shocks in 1953. According to appellee's argument, five sets of the Knoedler shocks were installed *prior* to the filing of the application for patents '938 and '235.

Appellant urges upon us that much of this evidence was untrustworthy and not possible of belief. That is argument better made to the district court than to us. Conceding that the evidence to support invention and public use was not uncontradicted:—concede that there existed, for example, "strong evidence that the Robertson units could not have

been made before 1956,"—and even conceding that a different result could have been arrived at by the district court, does not solve our problem. It cannot aid us in reversing the trial court's findings. The court's conclusions on disputed issues of fact are binding on us, unless we find them clearly erroneous. This, on the record before us, we cannot do.

IV

Nor does appellant's theory of the "abandonment" of Knoedler's combination devices require reversal. Cf. Corona Cord Tire Co. v. Dovan Chemical Corp., 1928, 276 U.S. 358, 48 S.Ct. 380, 72 L.Ed. 610; Brush v. Condit, 1899, 132 U.S. 39, 10 S.Ct. 1, 33 L.Ed. 251; Egbert v. Lippmann, 1881, 104 U.S. 333, 26 L.Ed. 755. And there was also evidence of a sale of the Knoedler device (Finding 26). 35 U.S.C. § 102(b).

V

We find and hold the district court's findings of fact are supported by the evidence, are not clearly erroneous, and that its correctly applied the law.

We affirm.

APPENDIX B

Opinion of the United States District Court, S. D. California 220 F. Supp. 941 (June 7, 1963; Findings of Fact, Conclusions of Law and Judgment, July 10, 1963)

CARR, District Judge.

This cause having come on for trial, the court having considered the evidence, the arguments, and the briefs, and being fully advised in the premises, it is the judgment of the court that plaintiff has failed to establish a case; that defendant is entitled to judgment; that both Patents No. 2,896,938 and No. 2,912,235 (hereinafter referred to as 938 and 235) are invalid; and that defendant has failed to sustain its counterclaims for damages for unfair competition and for attorney's fees. In order that the findings of fact, conclusions of law, and decree may be in keeping with the decision of the court, herewith follows the basis for the decision:

Respecting the cause of action for infringement of 938 and 235, the evidence compels the conclusion that such patents are invalid for want of invention since they are both a mere regrouping or utilization of old elements without change of function. Furthermore, the patents are invalid because they fail to disclose any inventive advance over the prior art in particular Exhibit E, French patent 1,044,393; Exhibit D, Italian patent, 467,071; Exhibit G, Farmer patent 2,344,858; Exhibit L, Chayne patent 2,159,203; Exhibit BD1, 1952 English Ford; and the Knoedler device, Exhibits AT and AL. The evidence clearly supports the conclusion that any advance over the prior art would have been obvious to a person skilled in the art, and in particular, there is no patentable invention involved in positioning a rubber sleeve around a shock absorber to prevent metal to metal contact and noise. Respecting the Knoedler device the

proof was clear and convincing that such device was known and used by others in this country before the invention thereof by the patentee Walker.

Respecting the validity of both 938 and 235, it is noted that the prior art heretofore mentioned was not cited by the Patent Office and, therefore, the presumption of validity is dissipated. Pressteel Company v. Halo Lighting Products, Inc. (9 Cir.), 314 F.2d 695.

Since the conclusion has been reached that neither 938 nor 235 is valid, it is unnecessary to make findings relative to infringement. Bliss v. Gotham Industries, Inc. (9 Cir.), 316 F.2d 848; Pressteel Company v. Halo Lighting Products, Inc. (9 Cir.), 314 F.2d 695.

Counsel for defendant is directed to prepare proposed findings of fact, conclusions of law, and decree pursuant to Local Rule 7.

FINDINGS OF FACT, CONCLUSIONS OF LAW AND JUDGMENT

This cause having come on regularly for trial before the Honorable Charles H. Carr, Judge of the United States District Court for the Southern District of California, Central Division, the Court having considered the evidence, arguments and the briefs and being fully advised in the premises, makes the following Findings of Fact and Conclusions of Law.

FINDINGS OF FACT

1. The plaintiff herein, MONROE AUTO EQUIPMENT COMPANY, is a corporation of the State of Michigan having its principal place of business at Monroe, Michigan.

2. Defendant, SUPERIOR INDUSTRIES, INC., is a corporation of the State of California having an established place of business at 14721 Keswick Street, Van Nuys, California, within the Southern District of California.

3. This cause of action arises under the Patent Laws of the United States of America and accordingly this Court has jurisdiction thereover.

4. On July 28, 1959 United States Letters Patent No. 2,896,938 entitled "VEHICLE SUSPENSION DEVICE" was issued to plaintiff, MONROE AUTO EQUIPMENT COMPANY, as the assignee of Brooks Walker.

5. On November 10, 1959 United States Letters Patent No. 2,912,235 entitled "AUTOMATIC AUXILIARY SUPPORT FOR A VEHICLE" was issued to plaintiff, MONROE AUTO EQUIPMENT COMPANY, as the assignee of Brooks Walker.

6. The defendant has within six years last past made and sold devices alleged by the plaintiff to infringe said Letters Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 in the Southern Judicial District of California and elsewhere in the United States.

7. Plaintiff has manufactured and sold devices constructed in accordance with the alleged inventions of said United States Letters Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235

8. On November 27, 1959 plaintiff's attorney on behalf of plaintiff charged defendant in writing with infringement of said Patent No. 2,896,938 and Claim 14 of said Patent No. 2,912,235. Plaintiff has also given notice of said patents upon devices made and sold by plaintiff constructed in accordance with the alleged inventions of said patents.

9. As evidence of the prior art, defendant introduced the following exhibits at the trial of this action:

French Patent No. 1,044,393 (Exhibit E)
Italian Patent No. 467,071 (Exhibit D)

Farmer U. S. Patent No. 2,344,858 (Exhibit G)
Chayne U. S. Patent No. 2,159,203 (Exhibit L)
1953 English Ford Front Suspension (Exhibit BD-1)

10. Prior art French Patent No. 1,044,393 and Italian Patent No. 467,071 disclose an auxiliary suspension device for vehicles consisting of a tubular shock absorber surrounded by a coil spring and means for supporting each end of such coil spring with respect to one of the relatively movable parts of the shock absorber. The arrangement of a tubular shock absorber surrounded by a coil spring in an automobile suspension was utilized in the prior art 1953 English Ford Front Suspension. (Exhibit BD-1). Although the English Ford front suspension incorporated a rubber sleeve on the shock absorber, such sleeve was not intended to act as a spacer and the coil spring did not buckle into contact with such sleeve. Prior art Farmer Patent No. 2,344,858 discloses the use of a rubber sleeve between a coil spring and a tubular metallic element encircled by such coil spring. Further, the use of rubber between relatively movable metal parts to avoid metal-to-metal contact is old. This was admitted by the plaintiff in Pre-Trial Conference Order Admitted Fact (Y).

11. At the trial of this action plaintiff specified that it was charging defendant with infringement of Claims 2, 3 and 4 of Patent No. 2,896,938.

12. Patent No. 2,896,938 in suit relates to an auxiliary vehicle suspension device that includes a conventional tubular shock absorber disposed within a coil spring. The shock absorber consists of two parts, one being a body portion 10 and the other a piston and rod. The piston rod telescopes into the body portion when the shock absorber is compressed. The piston rod is connected at its upper portion to a depending dust guard 11 having an outwardly flaring

flange 11a at its bottom. The ends of the coil spring are supported with respect to the relatively movable parts of the shock absorber. The specification of this patent recites "A sleeve 86 of non-metallic rubber or fiber material fits between the adaptor 80 and the flange 11a of the dust guard 11". It is the addition of this sleeve 86 to the prior art combination of a tubular shock absorber disposed within a coil spring that provides the basis for the assembly recited in Claims 2, 3 and 4 of Patent No. 2,896,938.

13. The combination of a tubular shock absorber and a coil spring surrounding such shock absorber as disclosed in Patent No. 2,896,938 was old in the prior art as set forth hereinabove. When these two old elements are united with a rubber sleeve there between there is no change in the respective functions of any of these elements, and the result is a mere aggregation of old elements. Accordingly, Claims 2, 3 and 4 of Patent No. 2,896,938 are invalid for want of invention.

14. The difference between the subject matter of Patent No. 2,896,938 in suit and the prior art as exemplified by the aforementioned prior art French Patent No. 1,044,393, Italian Patent No. 467,071, Farmer U. S. Patent No. 2,344,858 and the 1953 English Ford Front Suspension are such that the subject matter as a whole would have been obvious to one having ordinary skill in the automotive vehicle suspension art at the time of the alleged invention by the patentee Brooks Walker. In particular, in the assembly of a tubular shock absorber and a coil spring disposed substantially concentrically around said shock absorber there is no invention involved in positioning a rubber sleeve around said shock absorber to resist lateral movement of said spring and prevent metal-to-metal contact and noise. Accordingly, Claims 2, 3 and 4 of said Patent No. 2,896,938 fail to dis-

close any inventive advance over the prior art and said patent claims are invalid.

15. Prior to the time of the alleged invention of Patent No. 2,912,235 in suit it was old to provide a "sea-leg" rear shock absorber mounting for automotive vehicles. Thus, Pre-Trial Conference Order Admitted Fact (I.L.) states:

> "It was published in the S. A. E. Journal of 1949 that:
>
> > 'most cars have adopted what is known as the sea-leg mounting for the rear shock absorbers. The top mounting pin is closer to the center of the car than the lower one so that the shock leans inwardly at approximately a thirty degree angle. This has been found beneficial in providing lateral stability for the rear end, and in some instances made possible the elimination of a track bar'".

This "sea-leg" type of shock absorber mounting is disclosed in prior art Chayne Patent No. 2,159,203 wherein there is shown an automobile rear suspension including an axle 3, a pair of rear wheels 7 and 8, a frame 4 and a pair of "sea leg mounted tubular shock absorbers 29 and 30 interposed between the axle and the frame. Also interposed between the axle and the frame are main suspension springs 14 and 15.

16. Allegedly infringed Claim 14 of Patent No. 2,912,235 recites an automotive vehicle rear suspension that includes a frame, an axle, a pair of rear wheels, a pair of sea leg mounted tubular shock absorbers interposed between the frame and the axle, main suspension springs interposed between the frame and the axle and a coil spring surrounding each of said shock absorbers.

17. As set forth hereinabove it was old in the prior art to provide an automobile rear suspension including a frame,

an axle, a pair of rear wheels and a pair of sea leg mounted tubular shock absorbers interposed between the axle and the frame, with main suspension springs also being interposed between the axle and the frame. It was also old in the prior art to provide a tubular shock absorber surrounded by a coil spring, as exemplified by French Patent No. 1,044,393 and Italian Patent No. 467,071. Further it was old in the prior art to interpose a coil helper or auxiliary spring between a rear axle and the frame, as exemplified by Brooks Walker U.S. Patent No. 2,518,733 (Exhibit 53). When a coil spring is disposed around a sea-leg mounted tubular shock absorber in the rear suspension of an automotive vehicle, there is no change in the respective functions of any of the elements of such rear suspension, and the result is a mere aggregation of old elements. Accordingly, Claim 14 of Patent No. 2,912,235 is invalid for want of invention.

18. The difference between the subject matter of Claim 14 of Patent No. 2,912,235 in suit and the prior art as exemplified by the aforementioned Chayne Patent No. 2,159,203, French Patent No. 1,044,393, Italian Patent No. 467,071 and Brooks Walker Patent No. 2,518,733 are such that the subject matter as a whole would have been obvious to one having ordinary skill in the automotive vehicle suspension art at the time of the alleged invention by the patentee Brooks Walker. Accordingly, Claim 14 of Patent No. 2,912,235 fails to disclose any inventive advance over the prior art and said patent is invalid.

19. With respect to both Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 in suit, the usual presumption of validity which attaches to a patent is dissipated since the prior art French Patent No. 1,044,393, Italian Patent No. 467,071, Farmer Patent No. 2,344,858, Chayne Patent No. 2,159,203, and the 1953 English Ford Front Suspension were not cited by the Patent Office during the prosecution of said patents in suit.

20. Plaintiff was limited to a date of alleged invention of May 6, 1954 for Patent No. 2,896,938 in suit and a date of alleged invention of September 30, 1954 for Patent No. 2,912,235 in suit, i. e. the filing dates of said patents, since plaintiff failed to provide evidence of any earlier dates. Defendant produced clear and convincing proof that prior to these dates a device embodying the alleged invention of said patents was known and used in this country by Fred E. Knoedler and Harry Richard Knoedler both of Streator, Illinois. Additionally, the alleged invention of Claim 14 of Patent No. 2,912,235 was known and used in this country by John D. Truedson now of Phoenix, Arizona. Fred E. Knoedler constructed several pairs of so-called "Hydro Shock" booster springs as early as the Spring of 1953. These devices included a tubular shock absorber surrounded by a coil spring, with a rubber sleeve carried by the shock absorber and interposed between the shock absorber and the spring to resist lateral movement of said spring and prevent metal-to-metal contact and noise. Such Hydro Shock devices would have infringed Claims 2, 3 and 4 of Patent No. 2,896,938 if said devices were made after said patent issued. A pair of these Hydro Shock booster spring devices were mounted in a "sea-legs" fashion on the rear suspension of a 1949 Packard automobile owned by Fred E. Knoedler in the Spring of 1953. When so installed the assembly of said Hydro Shock devices on the rear suspension of this automobile would have infringed Claim 14 of Patent No. 2,912,235 if such assembly had been made after said patent issued. Hydro Shock devices operated satisfactorily and proved to be practical in supporting the rear end of the Fred E. Knoedler automobile whereon they were installed.

21. A pair of similar Hydro Shock booster springs made by Fred E. Knoedler and incorporating a rubber or plastic sleeve around the shock absorber were installed on

the 1949 Chevrolet of Harry Richard Knoedler in a "sea-leg" fashion during the Summer or Fall of 1953. John D. Truedson installed a pair of the Fred E. Knoedler Hydro Shock booster springs on his 1951 Oldsmobile in about August of 1953. It was not clear that Truedson's Hydro Shock booster springs included a rubber sleeve. However, it was clearly established that the shock absorbers on Truedson's automobile were mounted in a sea-leg fashion and were encircled by a coil spring. The Hydro Shock devices installed on the automobiles of Harry Richard Knoedler and John D. Truedson operated satisfactorily.

22. No attempt was made to keep the Knoedler Hydro Shock booster spring devices secret. These devices as installed on the 1949 Packard of Fred E. Knoedler were shown to members of the public including employees of Knoedler Manufacturers, Inc. of Streator, Illinois, employees of Beckman Motor Company of Streator, Illinois and the manager of Sig Automotive Parts, Streator, Illinois. Additionally, Knoedler Manufacturers, Inc. advertising (Exhibit AF and Exhibit AG) clearly disclosing the construction of the Hydro Shock booster springs and the sea-leg mounting thereof on the rear suspension of an automobile was sent out to various automotive parts distributors in the Fall of 1953.

23. Fred E. Knoedler filed U. S. Patent Application No. 377,880 on September 1, 1953 (Exhibit AL), which application was later forfeited. This application discloses the Hydro Shock booster spring in detail and includes all of the elements which make up the aggregation of Claims 2, 3 and 4 of Patent No. 2,896,938. Figure 1 of this patent application shows the Knoedler device mounted in a "sea-leg" position on the rear suspension system of an automobile. Hence, the disclosure of this application fully corroborates the other evidence relative to the construction of

the Hydro Shock booster spring devices and the mounting thereof in a "sea-leg" fashion on an automobile rear suspension.

24. The knowledge and use of the Fred E. Knoedler Hydro Shock device by others in this country prior to the alleged dates of invention of both patents in suit was clearly established by the evidence. Accordingly, said Knoedler device is a complete anticipation of Claims 2, 3 and 4 of Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 under the provisions of 35 U.S.C. § 102(a).

25. Knoedler Manufacturers, Inc. commencing with the Fall of 1953 attempted to market the Hydro Shock device. This attempt was unsuccessful because it was not possible to obtain shock absorbers at a reasonable price and because the Hydro Shock device was outside the farm equipment field in which Knoedler Manufacturers, Inc. was working. It was clearly established that the Hydro Shock devices used by Fred E. Knoedler, Harry Richard Knoedler and John D. Truedson operated satisfactorily and proved effective in supporting the rear end of a heavily loaded automobile. The design of the first Hydro Shock devices was not frozen and Fred E. Knoedler later developed a second type of device utilizing a coil spring that was clamped to the opposite ends of a shock absorber, but not utilizing a rubber sleeve. The Knoedler Hydro Shock device was reduced to practice and it was not an abandoned experiment.

26. Within the week preceding August 22, 1953 John D. Truedson sold his 1951 Oldsmobile with the pair of Hydro Shock devices still mounted in a "sea leg" fashion around the rear shock absorbers thereof. Truedson's automobile was sold to Jacobson Trailer Sales in Fergus Falls, Minnesota. Since this sale was made more than one year

prior to the date of filing of Patent No. 2,912,235, i. e. September 30, 1954. Claim 14 of said patent is invalid in accordance with the provisions of 35 U.S.C. § 102(b).

27. Since the conclusion has been reached that Claims 2, 3 and 4 of Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 are invalid, no findings are made as to infringement.

28. Defendant failed to sustain its Counterclaim for unfair competition.

Conclusions of Law

From the foregoing facts the Court makes the following conclusions of law.

1. This Court has jurisdiction over the subject matter of this action and over the parties.

2. Claims 2, 3 and 4 of Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 in suit are invalid for want of invention since they are directed to a mere aggregation and regrouping of old elements without change of function. (Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U.S. 147, 155, 71 S.Ct. 127, 95 L.Ed. 162.)

3. The differences between the subject matter of Claims 2, 3 and 4 of Patent No. 2,896,938 and the prior art are such that the subject matter as a whole would have been obvious to one having ordinary skill in the automotive vehicle suspension art at the time of the alleged invention by the patentee Brooks Walker. Accordingly, said patent claims are invalid in accordance with the provisions of 35 U.S.C. § 103.

4. The differences between the subject matter of Claim 14 of Patent No. 2,912,235 in suit and the prior art are such that the subject matter as a whole would have been obvious to one having ordinary skill in the automotive vehicle suspension art at the time of the alleged invention by the patentee Brooks Walker. Accordingly, Claim 14 of Patent No. 2,912,235 is invalid in accordance with the provisions of 35 U.S.C. § 103.

5. The Knoedler Hydro Shock device was known and used by others in this country before the alleged invention of the subject matter of Claims 2, 3 and 4 of Patent No. 2,896,938 and Claim 14 of Patent No. 2,912,235 by the patentee Brooks Walker. This prior knowledge and use is a complete anticipation of said patent claims. Accordingly, said patent claims are invalid in accordance with the terms of 35 U.S.C. § 102(a).

6. The sale of John D. Truedson's 1951 Oldsmobile equipped with a pair of "sea-leg" mounted Knoedler Hydro Shock devices in August of 1953, more than one year prior to the filing date of Patent No. 2,912,235 (September 30, 1954) renders Claim 14 of said patent invalid in accordance with the provisions of 35 U.S.C. § 102(b).

JUDGMENT

In accordance with the foregoing Findings of Fact and Conclusions of Law it is ordered, adjudged and decreed:

1. That the Complaint be dismissed.

2. That defendant's Counterclaim be dismissed.

3. That Claims 2, 3 and 4 of Patent No. 2,896,938 are invalid.

4. That Claim 14 of Patent No. 2,912,235 is invalid.

5. That costs be assessed against plaintiff and in favor of defendant in the amount of $1557.86.

Office-Supreme Court, U.S.
FILED
SEP 21 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 411

MONROE AUTO EQUIPMENT COMPANY,
Petitioner,

v.

SUPERIOR INDUSTRIES, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

MONROE AUTO EQUIPMENT COMPANY, *Petitioner,* v. SUPERIOR INDUSTRIES, INC., *Respondent.*	No. 411

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Respondent prays that this Court deny the Petition For A Writ Of Certiorari.

Statement of the Case

The statement of the case would not be complete without a reference to the fact that the case does not involve an appellate court conflict. On the contrary, both the Sixth and the Ninth Circuit appellate courts have held United States Patent No. 2,896,938 in suit invalid, affirming their District Court rulings of invalidity. Both District Courts found the patent invalid for the same reasons, namely lack of invention over the prior art and anticipation by the prior knowledge and use of the Knoedler Hydro Shock device. The Sixth Circuit Court of Appeals case is *Monroe Auto Equipment Company v. Heckethorn Manufacturing & Supply Company* (No. 15354) decided May 14, 1964 and reported at 141 USPQ 549.

Petitioner's statement of the case, as would be expected, leaves out many other facts detrimental to the Petitioner. It does

not appear necessary, however, to burden this Court with a detailed recital of such facts for the purpose of this proceeding.

Argument

A: *The Alleged Questions Presented*

The first question presented is set forth immediately herebelow:

> "1. May 35 U.S.C. § 103 be made to turn on structural similarity rather than conceptual unobviousness, without regard to well-settled indicia of the latter including extensive prior efforts with failure and the presumption of validity?"

This question has already been answered in the negative by the Ninth Circuit Court of Appeals.

In its appeal to the appellate court Petitioner framed this same question in somewhat different language. In said appeal Petitioner accused the District Court of using "subjective hindsight" as a test of validity rather than looking at the "various objective criteria of invention" (Appendix vii of Petitioner's Writ). The appellate court, however, clearly stated that it had considered all of the arguments advanced by Petitioner as showing "conceptual unobviousness" but still agreed with the District Court that the patent in suit was invalid for lack of invention. The thoroughness of the appellate court's review of Petitioner's so-called "well-settled indicia" of conceptual unobviousness will be apparent by a review of Pages vii to xvi of the appellate court's opinion appearing at the Appendix to Petitioner's Writ.

The second question presented is set forth immediately herebelow:

> "2. Can evidence not clear and convincing be adequate proof of prior knowledge and use?"

The answer to the above question is of course "No".

Petitioner argued before the Ninth Circuit Court of Appeals that the evidence of prior knowledge and use of the Knoedler device was not clear and convincing. The appellate court replied that even though the evidence to support such knowledge and use was not uncontradicted, on the record before the appellate court, this evidence was not clearly erroneous and hence the appellate court refused to reverse the findings of the District Court.

It will therefore be apparent to this Court that the decision of the Ninth Circuit Court does not properly raise either of the questions presented by the Petitioner. With respect to the first question presented, the appellate court carefully reviewed the so-called well-settled indicia of conceptual unobviousness, rather than relying solely on structural similarity. With respect to the second question, the appellate court held that on the factual record before it the evidence of prior knowledge and use was clear and convincing.

Accordingly, Petitioner is really asking this Court to review the facts of this case and render a new decision which Petitioner hopes will be the reverse of the decisions previously rendered in this case.

B. *The Alleged Reasons For Granting The Writ*

The first reason advanced by Petitioner for granting the writ appears immediately herebelow:

> "a. petitioner's patent has been invalidated by a decision in conflict with this Court's decision in *Eibel Co. v. Paper Co.*, 261 U.S. 45 (1923);"

The above reason is completely fallacious because the appellate court decision in this case is in no manner in conflict with this Court's decision in the *Eibel* case. In this case, as in the *Eibel* case, validity depended upon whether or not the small

change made by the patentee amounted to invention. Under the facts of the *Eibel* case it was held that such a small change did amount to invention. Under the facts of the present case, the small change was held to lack invention. The only conflict between the two decisions is in the ultimate outcome, not in the law followed to obtain such outcome.

The second reason advanced by Petitioner for granting the writ appears immediately herebelow:

> "b. it is of public importance to clarify that the statutory requirement of unobviousness is concerned with the character of the inventor's real-life conceptual contribution, not with whether physical devices animated by his conception are more or less similar to what was old, and in this connection to clarify the import of *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545 (1938) on this frequently recurring point;"

According to the above reason, Petitioner feels it is of public importance for this Court to clarify the import of its decision in the *Lincoln* case. Respondent submits that this Court's decision in the *Lincoln* case is perfectly clear. The appellate court below had no trouble whatever in applying the law of the *Lincoln* case to the factual situation herein. Hence, this second reason advanced for granting the writ is also inadequate.

The third reason advanced by Petitioner for granting the writ appears below:

> "c. the decision below is in conflict, as to standard of proof of prior use and knowledge, with a line of decisions of this Court including *The Barbed Wire Patent*, 143 U.S 275 (1892)."

With respect to this reason, Respondent respectfully points out to this Court that the *Barbed Wire* case is not in point since in that case the anticipation was established solely by oral testimony. In this case the oral testimony establishing evidence of

prior knowledge was supplemented by considerable documentary and physical evidence including Knoedler's catalog sheet, price sheet and patent application (Page xx of Appendix to Petitioner's Writ). This totalitary of evidence constituted "clear satisfactory and beyond a reasonable doubt" proof to the District Court as to the prior knowledge and use. On the record before the appellate court the latter refused to reverse the trial court's findings and substitute its judgment for that of the trial court in weighing the evidence. It is, therefore, untrue that the decision below is in conflict with the standard of proof of prior use and knowledge set forth in various decisions of this Court including the *Barbed Wire* case.

Conclusion

From the foregoing it will be apparent to this Court that the issue involved in this patent case is the usual issue of validity. The applicable law was, in fact, applied below and on its merits the patent in suit found invalid.

The Petitioner having lost both in the Sixth and the Ninth Circuits seeks to create something special which would warrant judicial review by this Court. The questions Petitioner poses do not find support in the record below nor in the decisions of the District or Circuit Courts. In grasping for the special and important reasons which would raise this case from the status of a mundane patent case, Petitioner has presented two questions for granting the writ. Both the questions presented and the reasons advanced for this Court's consideration of the questions, however, are completely spurious. Petitioner's questions therefore fail to define any clear-cut issue warranting this Court's review and Petitioner's Writ should be denied.

Respectfully submitted.

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